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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,409	09/14/2005	Roque Humberto Ferreyro	101896	1699

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EXAMINER	
SIGLER, JAY R	
ART UNIT	PAPER NUMBER
3733	

NOTIFICATION DATE	DELIVERY MODE
03/20/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

Office Action Summary	Application No.	Applicant(s)	
	10/549,409	FERREYRO ET AL.	
	Examiner	Art Unit	
	JAY R. SIGLER	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-77* is/are pending in the application.

4a) Of the above claim(s) *1-36, 40-67, and 69-77* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-40 and 68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 September 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *23 March 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group III, claims 37-40 and 68, in the reply filed on 22 January 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-36, 40-67, and 69-77 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 22 January 2008.

Drawings

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because in general, the drawings are of poor quality and reference numbers are hard to read. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

4. Figures 2-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled

"Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because it exceeds 150 words.

Correction is required. See MPEP § 608.01(b).

7. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 37-40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 53-56 of copending Application No. 10/947,496. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

10. Claims 37-40 are directed to the same invention as that of claims 53-56 of commonly assigned Application No. 10/947,496. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Dardik et al. (US 4,250,887). Dardik et al. teaches:

a. Concerning claim 37: a method for delivering a viscous material under a radiation field 14 and capable of delivering a viscous material (col. 3, l. 64) under fluoroscopy (naturally follows from x-ray field 14 which in the sense of desirability of reducing exposure to radiation is functionally equivalent) to a site in a patient comprising the steps of: a) providing a delivery tube containing an incompressible fluid and a viscous material, wherein the viscous material is located within the radiation field, in which a fluoroscopy field would be functionally equivalent (col. 4, ll. 51-53; 24 pumps material through 27 which is seen in the x-ray field in Fig. 1); and b) pressurizing the incompressible fluid outside the radiation field, in which a fluoroscopy field would be functionally equivalent, to exert pressure on the viscous material (Fig. 1; col. 2, l. 61 to col. 3, l. 15).

b. Concerning claims 38-40: the delivery tube 33 is flexible and noncompliant (col. 4, ll. 15-20); a linear actuator 22 is involved; determining the amount delivered can be made from a visualization window 20 (col. 5, ll. 3-7).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 37 and 68 rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Assir (US 6,676,664) in view of Dardik et al. (US 4,250,887). Al-Assir teaches a method for delivering a viscous material, namely bone cement, under a radiation field (col. 2, ll. 5-8) and capable of delivering a viscous material, namely bone cement (col. 5, ll. 13-15), under fluoroscopy (naturally follows from x-ray field, which in the sense of desirability of reducing exposure to radiation is functionally equivalent), which includes the viscous material in the radiation field, but includes pressurizing the viscous material using mechanical means rather then hydraulic means.

Dardik et al. teaches a method for delivering a viscous material (col. 3, l. 64) under a radiation field 14 and capable of delivering a viscous material, namely bone cement (naturally follows from similar structure to applicant), under fluoroscopy (naturally follows from x-ray field 14 which in the sense of desirability of reducing exposure to radiation is functionally equivalent) to a site in a patient comprising the steps of: a) providing a delivery tube containing an incompressible fluid and a viscous material, wherein the viscous material is located within the radiation field, in which a fluoroscopy field would be functionally equivalent (col. 4, ll. 51-53; 24 pumps material through 27 which is seen in the x-ray field in Fig. 1); and b) pressurizing the incompressible fluid outside the radiation field, in which a fluoroscopy field would be functionally equivalent, to exert pressure on the viscous material (Fig. 1; col. 2, l. 61 to

col. 3, l. 15). Dardik et al. teaches this method in order to reduce the radiation exposure to the surgeon (Abstract).

It would have been obvious to someone of ordinary skill in the art at the time of the invention to substitute the steps and apparatus of Dardik et al. into the method of Al-Assir because the substitution would have yielded predictable results, namely to reduce the radiation exposure of the surgeon.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for other pertinent art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAY R. SIGLER whose telephone number is (571)270-3647. The examiner can normally be reached on Monday through Thursday from 8 AM to 4 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JRS/

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733